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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/803,181 | 03/16/2004 | Gary Lee Butler | 12929.1132US01 | 5114 |
| 58506 | 7590 | 03/07/2006 | EXAMINER | |
| FAEGRE & BENSON, LLP ATTN: PATENT DOCKETING 90 SOUTH SEVENTH STREET 2200 WELLS FARGO CENTER MINNEAPOLIS, MN 55402 | | | BASICHAS, ALFRED | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3749 | |
| DATE MAILED: 03/07/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,181

Applicant(s)

BUTLER ET AL.

Examiner

Alfred Basichas

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3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claims 29 and 30 are objected to because of the following informalities: Their dependency has been changed to claim 33 without the proper underlining as required for amending the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102/103

2. Claims 1, 8, 10, 14, 17, 19, 20, 23, and 24 are rejected under 35 U.S.C. 102(b) as anticipated by Gazco (GB2293875), Matsushita (JP59097416), Ecological (3,685,946), Nabisco (4,786,247), Hamilton (GB387751), and Int. Comb. Eng. (1,734,669) as applied in applicant's foreign application no. GB0503003.6.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3, 6-8, 10-14, 17, 18, 23-25, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannebaum (3,499,432) in view of Fleming (5,678,534). Hannebaum discloses a fireplace housing including, among other things, a combustion chamber configured as a glass cylinder 26 (see at least fig. 1), and a source of fluid 18 providing rotating fluid flow (see at least fig. 1) thereby creating an air curtain that both feeds the flame and cools the glass cylinder walls. It should be noted that the invention disclosed by Hannebaum can be utilized with solid fuel such as wood and therefore be inherent that the combustion air would mix with the fuel before the flame is

produced. It is further inherent that the moving fluid would increase the burn efficiency by adding more oxygen. Notwithstanding the use of Hannebaum's invention with wood as a fuel source, many fireplaces today have been converted to display devices utilizing artificial ambers. An exemplary model is that described by Fleming. Fleming teaches a fire display/fireplace including artificial ambers 30 and gas fuel nozzle 5 to provide for a more efficient and esthetically pleasing effect. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the burner and artificial ambers of Fleming into the invention disclosed by Hannebaum, so as to provide for a more efficient and esthetically pleasing effect.

7. Claims 5, 9, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frink (US2004/0261780) or Hannebaum (3,499,432) in view of Fleming (5,678,534). Frink and Hannebaum in view of Fleming do not specifically recite a compressed fluid in place of the blower or a light source.

a. As regards the compressed fluid, Official Notice is given that functional equivalence and interchangeability of a compressed fluid and blower is old and well known in the art. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a compressed fluid into the invention disclosed by Frink or Hannebaum in view of Fleming, so as to provide for manufacturing costs and availability.

b. Official Notice is given that providing a light source in a fireplace is old and well known in the art. Such an arrangement has the clear and obvious benefit of providing for increasing visibility and providing an appealing esthetic effect.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a light source into the invention disclosed by Frink or Hannebaum in view of Fleming, so as to provide for increasing visibility and providing an appealing esthetic effect.

Response to Arguments

8. Applicants' arguments with regard to the rejected claims, filed January 17, 2006, have been considered, but are not deemed fully persuasive.

- a. In light of applicants' amendments and arguments the rejection of the claims over Frink is withdrawn.
- b. As regards applicants' amendments directed at the remainder of the rejections, applicant alleges that the prior art fails to disclose or make obvious "creating a pulsating flame, a short and stubby flame, a tall and thin flame, a swirling or twisting flame, etc." First it should be noted that the references do indeed disclose short (see at least Matsushita), tall (see at least Gazco), and swirling flames (see at least Hannebaum). As regards a pulsating flame, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In addition, if it is applicants' intent that the flame size and shape be variable, there appears to be

a lack of sufficient disclosure to enable one of ordinary skill in the art to make and/or use the invention without undue experimentation.

c. In addition, applicants assert that the prior art devices will result rotational characteristics substantially different than that resulting from their invention.

Again, , it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Basichas whose telephone number is 571 272


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4871. The examiner can normally be reached on Monday through Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571 272 4828. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center telephone number is 571 272 3700.

March 2, 2006


Alfred Basichas
Primary Examiner